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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,807	12/07/1999	John Beezer	3797.84618	5593

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EXAMINER

SAX, STEVEN PAUL

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/455807

Applicant(s)

Becker et al

Examiner

Sax

Group Art Unit

2174

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-30 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-30 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 516
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

1. This application has been examined.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-6, 13-18, 25, 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (6389434).

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4. Regarding claim 1, Rivette et al show a computer implemented method for annotating a system (abstract, Figures 6a, 7a-b, 20, column 4 lines 1-10). The system has a display for displaying an immutable (non-modifiable) page of a document having objects (column 10 lines 17-25, column 9 lines 27-40). The system receives an indication that an object is to be annotated (column 11 lines 10-20, Figures 15, 16, 17, column 12 lines 45-50), and provides a window to the user having a portion for receiving the annotation of the object and a portion for allowing navigation to another object annotation (column 11 lines 33-38, 43-48, 55-65, column 12 lines 43-68, column 13 lines 29-35).

5. Regarding claim 2, the system receives a selection of the object and a menu item is selected to provide the window (for example Figures 9, 16, column 14 lines 15-24).

6. Regarding claim 3, the system receives user input and displays another annotation (column 13 lines 10-15).

7. Regarding claim 4, the non modifiable document page is maintained irrespective of the annotation display (column 15 lines 15-26).

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8. Regarding claims 5-6, multiple annotations may be made, in which then multiple non modifiable pages are displayed which may overlies (column 11 lines 25-50, Figure 30, 31b, 32, column 15 lines 35-47, column 17 lines 14-24).
9. Claims 13-18 have the same features as above and are rejected for the same reasons.
10. Regarding claim 25, in addition to the aforementioned, note the storage device (column 9 lines 58-68) which implicitly determines the file position of the object in order to access it (column 10 lines 1-7).
11. Regarding claim 28, in addition to the reasons given for claim 25, note also the data fields (column 19 lines 30-60).
12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 7-12, 19-24, 26-27, 29-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (6389434).

14. Regarding claim 7, in addition to the aforementioned, Rivette et al do not specifically mention displaying an indication that the text annotation has been stored in conjunction with an object on the non modifiable page, but as shown above the annotation is displayed in conjunction with an object on the page. The system also has storage capabilities and furthermore retrieves and loads annotations (column 12 lines 60-68 and column 13 lines 1-16) in an organized way. It would have been obvious to a person with ordinary skill in the art to store the annotation with the object on the page, because it would provide a convenient way to later retrieve and load the annotations in an organized way.

15. Regarding claim 8, the position of the object is determined (Figures 7a, 8, 9, 10). It would have been obvious to a person with ordinary skill in the art to store the position and annotation in a separate area from the document, because it would provide a convenient way to later retrieve the information in an organized way.

16. Regarding claims 9 and 10, note the stylus and mouse (column 10 lines 28-32, column 14 lines 30-38).

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17. Regarding claims 11 and 12, it would have been obvious to a person with ordinary skill in the art to count bytes to determine the position of the object, because it would provide a thorough way to track a position for later retrieval. This may be accomplished by counting bytes from the beginning of the page to the annotation, using another object as a middle point.

18. Claims 19-24, 26-27, 29-30 show the same features as above and are rejected for the same reasons. In addition, it would have been obvious to a person with ordinary skill in the art to store the annotation and position in a modifiable portion of the document, because it would provide convenient retrieval to mutually modifiable portions.

19. Any inquiry concerning this communication should be directed to Steve Sax at telephone number (703) 305-9582.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Sax whose telephone number is (703) 305-9582. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

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(703) 746-7238

After Final Communication


(703) 746-7239

Official Communication

(703) 746-7420

For Status Inquiries, draft communication

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



STEVEN SAX
PRIMARY EXAMINER